

**REMARKS**

This paper is responsive to the Office Action identified above, and is responsive in any other manner indicated below.

**PENDING CLAIMS**

Claims 1-11 and 18-29 were under consideration and subjected to examination in the Office Action. Appropriate claims have been amended, deleted and/or added in order to adjust a clarity and/or focus of Applicant's claimed invention. That is, such changes are unrelated to any prior art or scope adjustment and are simply refocused claims in which Applicant is presently interested. At entry of this paper, Claims 1-11 and 18-29 remain pending for further consideration and examination in the application.

**REJECTION UNDER §112, 2<sup>ND</sup> ¶ OBVIATED VIA CLAIM AMENDMENT**

Claims 1-11 and 18-29 have been rejected under 35 USC §112, 2<sup>ND</sup> ¶, as being indefinite for the concerns listed within the section beginning on page 2 of the Office Action. All such claims have been carefully reviewed and carefully amended where appropriate in order to address the Office Action listed concerns. As the foregoing is believed to have addressed all §112, 2<sup>ND</sup> ¶, concerns, reconsideration and withdrawal of the §112, 2<sup>ND</sup> ¶, rejection are respectfully requested.

**§101 REJECTION RE INOPERATIVENESS AND LACK OF UTILITY-TRAVERSED**

Claims 1-11 and 18-29 have been rejected under 35 USC §101 as allegedly lacking patentable utility, *i.e.*, for the concerns listed within the section beginning on

page 4 of the Office Action. Applicant respectfully traverses. As stated in MPEP §2107 entitled "General Principles Governing Utility Rejections":

to violate [35 USC] 101 the claimed invention must be totally incapable of achieving a useful result. . . . A small degree of utility is sufficient . . . The claimed invention must only be capable of performing some beneficial function . . . An invention does not lack utility merely because the particular embodiment disclosed in the patent lacks perfection or performs crudely . . . A commercially successful product is not required . . . Nor is it essential that the invention accomplish all its intended function . . . or operate under all conditions . . . partial success being sufficient to demonstrate patentable utility . . . In short, the defense of non-utility cannot be sustained without proof of total incapacity. If an invention is only partially successful in achieving a useful result, a rejection of the claimed invention as a whole based on a lack of utility is not appropriate. (underline emphasis added)

Applicant respectfully submits that the claimed invention has the sufficient utility of allowing inspection of DNA chips so as to ultimately arrive at, for example, information from the DNA chip as derived from a detected image of reflected fluorescent lights. Office Action comments state: "While some of the claims do recite method steps that involve a DNA chip, the claims do not culminate in the determination of any specific and useful result. Simply 'inspecting' for some unknown quantity in and of itself does not constitute patentable utility."

Traversal is appropriate. More particularly, as mentioned above, it is not essential (for §101 utility purposes) that the invention totally accomplish its intended function. Here, Applicant's invention arrives at information from the DNA chip as derived from a detected image of reflected fluorescent lights. What one does with such information after it is obtained is of no concern to Applicant's invention, and in fact, users would use/interpret such information in different ways for different uses. In short, Applicant invention has sufficient utility as useful information is derived by

inspection of DNA chips. Based upon the foregoing, reconsideration and withdrawal of the §101 rejection of the above-referenced claims are respectfully requested.

#### **CONDITIONAL AUTHORIZATION FOR NON-ELECTED CLAIMS**

In the event that the above response otherwise places the application in condition for allowance, and the only remaining issue preventing allowance is the existence of non-elected claims, the Examiner is herein authorized to cancel any non-elected claims to effect allowance.

#### **EXTENSIVE PROSECUTION NOTED**

Applicant and the undersigned respectfully note the extensive prosecution which has been conducted to date with the present application, and thus, Applicant and the undersigned would gratefully appreciate any considerations or guidance from the Examiner to help move the present application quickly to allowance.

#### **ENTRY AFTER FINAL REJECTION**

For all of the foregoing reasons, Applicant submits that the present paper should be entered since it places the rejected claims in condition for allowance by complying with the Examiner's requirements and/or amending and/or arguing the claims to distinguish such claims from the applied prior art.

Alternatively, this response should be entered since it presents the rejected claims in better form for consideration on appeal.

### EXAMINER INVITED TO TELEPHONE

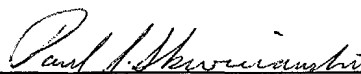
The Examiner is invited to telephone the undersigned at the local D.C. area number 703-312-6600, to discuss an Examiner's Amendment or other suggested actions for accelerating prosecution and moving the present application to allowance.

### CONCLUSION

In view of the above amendments and remarks, Applicant submits that the claims under consideration, *i.e.* Claims 1-11 and 18-29, should now be considered to be in compliance with 35 U.S.C. §101 and 35 U.S.C. §112, 1<sup>ST</sup> and 2<sup>ND</sup> ¶s. Therefore, Claims 1-11 and 18-29 also should now be in condition for allowance, and issuance of a Notice of Allowance is courteously solicited.

To the extent actually necessary, Applicant petitions for an extension of time under 37 CFR §1.136. Please charge any shortage in the fees due in connection with the filing of this paper to ATS&K Deposit Account No. 01-2135 (500.39147X00).

Respectfully submitted,



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### ATTACHMENTS:

Petition for Extension of Time  
Notice of Appeal  
Form PTO-2038